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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,498	09/22/2003	Chan-Tung Chen	3624-0127P	6843
2292	7590	11/23/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			HUNTER, ALVIN A	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/665,498

Applicant(s)

CHEN ET AL.

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8 and 11-15 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 6, 7, and 12-15 are rejected under 35 U.S.C. 102(a & e) as being anticipated by Takeda (USPN 6491593).

In regards to claim 1, Takeda discloses a golf club head 2 comprising a golf club head body made of elements 7 and 10 including a recession wherein the recession has a shoulder on an inner peripheral edge wherein the shoulder further includes at least one annular groove, at least one ring 9 mounted on the shoulder of the golf club head body, and a striking plate 8 mounted in the recession of the golf club head body so that the ring is sandwiched in-between the striking plate and the shoulder of the golf club head body wherein the striking plate being securely engaged with the ring wherein the ring supports a rear side of the striking plate (See Figure 1 and 6).

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In regards to claim 2, the ring is made of a material inherently having a Young's Modulus smaller than 3×10^7 psi, wherein the material is stainless steel (See Column 3, lines 36 through 44).

In regards to claim 4, Takeda discloses the recession of the golf club head body to include a flange 11 that is also the filling material on an outer peripheral edge and the striking face including a step portion 12. Claim 4 is a product by process claim, therefore, it is submitted that the process for creating the filling material has not patentable weight so long as the final product is achieved.

In regards to claim 7, Takeda shows in Figure 1, the striking plate supported by the ring wherein a gap between the shoulder of the club head and the striking plate.

In regards to claims 12 and 13, Takeda discloses the striking plate made of a material inherently having a Young's Modulus smaller than 3×10^7 psi wherein the material is titanium alloy (See Column 3, lines 8 through 22).

In regards to claims 14 and 15, Takeda discloses the club head body made of a material inherently having a Young's Modulus greater than 3×10^7 psi wherein the material is stainless steel (See Column 3, lines 8 through 22).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda (USPN 6491593).

In regards to claim 6, Takeda in Figure 7 having a notch 14 in each opposed annularly extending corner portions. Takeda discloses the notch being a weld for securing the ring to the golf club head body which Figure 7 shows as reducing the contact area between the striking plate and the shoulder of the golf club head body. Applicant does not disclose why it is critical to press fit the ring to reduce the contact area; therefore, one having ordinary skill in the art would have sought the method of reducing the contact area to be an obvious matter of design choice. The weld process of Takeda would have performed equally as well because it reduces the contact area between the striking plate and the shoulder of the golf club head body. In regards to having a plurality of notches, the notch of Takeda reduces the contact area, therefore, it would have been obvious to have more than one notch in order to further reduce the contact area.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda (USPN 6491593) in view of Chen et al. (USPN 5743813).

In regards to claim 8, Takeda does not disclose the gap between the striking face and golf club head body being filled with a filling material. Chen et al. discloses a golf club head having a filling material 3 filling a gap between the striking plate and the golf club head body (See Abstract and Figure 3). One having ordinary skill in the art would have found it obvious to have a filling material in the gap of Takeda, as taught by Chen et al., in order to reduce the shock produced by the golf club when striking a golf ball.

Allowable Subject Matter

Claims 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 8/20/2004 have been fully considered but they are not persuasive. Applicant argues that the prior art does not anticipate because it does not show a ring member sandwiched in between a shoulder and striking plate. The examiner disagrees. Figure 6 clearly shows the limitations claimed by the applicant in the sole independent claim. The weight is part of the golf club body. Applicant does not originally disclose any language excluding the weight as constituting part of the club head body. For these reasons, the above rejection has been furnished.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQH

Alvin A. Hunter, Jr.


Steven Wong
Primary Examiner